

Sub E3.1
30.(Amended) A mascara composition for application to the eyelashes comprising about 0.05 to about 0.50 percent by weight of the composition of a seedless but otherwise substantially whole processed apple extract of tacky constituents dispersed in a cyclomethicone, a non-plant fiber component comprising nylon and chitin, an antistatic component comprising chitin, and said whole processed apple extract comprising a natural apple fiber component.

REMARKS

The Examiner finds that there is a difference between "whole processed fruit or vegetable" and "extract," and that this difference serves as the basis for a novelty and obviousness rejection of the present claims. However, as Applicants point out now and in previous responses, the present specification defines extract as used in the present application to be the substantially whole processed fruit or vegetable, without the seeds, and therefore, is not the active principle disclosed in the cited reference. According to the definition in the present specification, and as the terms are used therein, the extract of the present invention is substantially the whole fruit or vegetable. However, as suggested by the Examiner, Applicants amend the present claims to more clearly define the extract of the present invention. Thus, the present invention, as amended, is a mascara composition that contains a substantially whole processed fruit or vegetable extract that contains tacky constituents. Specifically at page 3, lines 24 to 32, the term "extract" is defined to have this special meaning such that the extract is prepared using seedless but otherwise whole fruit or vegetable. The tacky components (e.g., pulp, sugars, and skin) of the fruit or vegetable are not separated or purified to make the whole processed fruit or vegetable extract of the present invention. The nuance of the present invention is the substantially whole processed fruit or vegetable extract whereby the pulp and skin are present in the extract of the present invention, and this is not disclosed by the Pastour reference cited by the Examiner.

In the Advisory Action, it is suggested by the Examiner that an even more descriptive explanation of the difference between the prior art use "extract" and the use of "extract" in the present invention be provided. Applicants believe that a thorough explanation of the term "extract" as it is used in the present specification is provided in the specification as indicated above. It is not clear what additional information about the term as it is used in the present specification would be necessary when one of ordinary skill in the art would understand that tacky constituents in an extract are not the active principles disclosed in the Pastour reference. For the reasons below, the cited reference fails to disclose a composition containing a seedless but substantially whole processed fruit or vegetable extract as such is defined in the present specification.

The active principle of the Pastour reference is not a tacky constituent of the plant extract. One of ordinary skill in the art would recognize that the presence of the tacky constituents from the unfiltered plant are likely to interfere with the activity of the desired active principle and that the mixture of these tacky constituents from the whole plant may cause other qualitative disadvantages to the final composition. The substantially whole processed extract of the present invention containing tacky constituents, is essentially opposite the active principle taught in the Pastour reference, and thus, the Pastour reference fails to disclose, expressly or inherently, the present invention.

Further, the Pastour reference fails to disclose the substantially unfiltered whole processed fruit or vegetable extract dispersed in a silicone oil. Because the Pastour reference does not disclose a seedless but otherwise whole processed fruit or vegetable extract and because it does not disclose any type of fruit or vegetable extract dispersed in a silicone oil, it does not anticipate the present invention, as amended. Therefore, the rejection under 35 U.S.C. §102(b) should be withdrawn.

The Examiner asserts that the Pastour reference also renders the present invention obvious because the Pastour reference teaches plant extract and according to the Examiner, this includes any and all plants. However, as previously pointed out, the Pastour reference does not disclose *carte blanche*, plant extracts, because it merely discloses active principles such as plant extract. The Pastour reference teaches a plant extract as an example of an active principle removed from the other tacky constituents of the plant. So while, the plant extract can include both vegetable and fruit extract, in any and all cases, the extract taken from the vegetable or fruit source is only the active principle, and not its tacky constituents. This has not been addressed by the Examiner. M.P.E.P. 707.07(f). As the Examiner mentions, the expected result is a mascara with beneficial qualities, but assuming *arguendo* that this is true, it would presumably only be so because the plant extract, *inter alia* is taught solely as the active principle. There is no teaching or suggestion in the Pastour reference to incorporate tacky constituents from a whole fruit or vegetable in a mascara composition. Therefore, the Examiner fails to set forth a *prima facie* case of obviousness.

The achievement of the present invention is surprising and unexpected as evidenced by the results provided in the specification and as mentioned in Applicants' previous response of January 2, 2001. However, the Examiner in the present action, as in previous actions, interprets the study described in the present specification to mean that 80% (the actual number is 87%) or more of the participants rate the mascara of the present invention as performing the same as their currently used mascara, and therefore, the Examiner concludes that the results of the present invention are not unexpected. Applicants still assert that this conclusion is not accurate.

The Pastour reference is no different than conventional mascaras, and the ability of the mascara of the present invention to perform as well as traditional mascara is indeed unexpected because it contains tacky components of the fruit or vegetable which would be expected to cause the mascara to perform poorly. As the Examiner has noted the mascara should be easy to apply, soft, uniform, and have good sensory qualities. One of ordinary skill in the art would not expect a mascara formula containing whole fruit and vegetable extract with tacky constituents to achieve these qualities at all, nonetheless to perform comparably to a conventional mascara. However, surprisingly and unexpectedly, the mascara of the present invention containing unfiltered whole processed fruit or vegetable extract (i.e., containing sticky sugary, gummy and tacky pulp) is favorably compared with conventional mascaras that do not contain these ingredients and it remains that the Examiner has not explained how this could be anything but surprising.

Finally, the Pastour reference fails to teach or suggest the whole processed seedless apple extract dispersed in a cyclomethicone as described in Claim 30. The Pastour reference discloses that its aqueous phase can comprise active principles such as plant extracts. There is no teaching or suggestion to add, for example, the whole processed apple extract of tacky constituents to the Pastour compositions. Nor is there any teaching or suggestion to disperse the whole processed apple extract in cyclomethicone. Therefore, in addition to the arguments presented above with respect to the extract of the present invention containing tacky constituents, the specific whole processed apple extract dispersed in cyclomethicone is not taught or suggested by the Pastour reference.

Applicants submit that the amended claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because the Pastour reference fails to teach or suggest a substantially unfiltered whole processed fruit or vegetable extract as described in the present specification. Unlike the present invention, as amended, the plant extract in the Pastour reference is separated from the whole plant. Further, the mascara of the present invention containing the unfiltered whole processed fruit or vegetable extract is surprisingly and unexpectedly non-tacky. The Examiner recommend submitting data to show unexpected results in the discussion regarding the novelty of the invention. However, since unexpected results can be provided to rebut a *prima facie* case of obviousness not novelty, in the present case, Applicants believe that *prima facie* case has not been made. Therefore, Applicants believe that there is no burden on Applicants to submit such data. However, surprising and unexpected results are provided in the present specification and they demonstrate the non-obvious nature of the present invention because a mascara containing tacky constituents would be expected by one of ordinary skill in the art to be tacky especially when compared to conventional mascara. The present invention, however, belies such logic and is substantially non-tacky, even in comparison with conventional mascara. Thus, Applicants

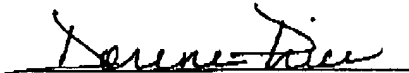
maintain that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because the Pastour reference fails to teach or suggest a substantially whole processed fruit or vegetable extract containing tacky constituent, and Applicants request that the Examiner's rejection be withdrawn.

CONCLUSION

Applicants believe that the present claims are patentable over the cited prior art reference. Accordingly, the claims, as amended, are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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MARKED AMENDMENTS

Please amend Claims 1, 25, and 30 as follows:

1.(Amended) A mascara composition comprising a seedless but otherwise substantially whole processed fruit or vegetable extract of tacky constituents dispersed in a silicone oil.

25.(Amended) A mascara composition comprising a seedless but otherwise substantially whole processed fruit or vegetable extract of tacky constituents dispersed in a volatile silicone oil, an antistatic component, a non-plant fiber component, and said whole processed fruit or vegetable extract comprising a natural fiber component.

30.(Amended) A mascara composition for application to the eyelashes comprising about 0.05 to about 0.50 percent by weight of the composition of a seedless but otherwise substantially whole processed apple extract of tacky constituents dispersed in a cyclomethicone, a non-plant fiber component comprising nylon and chitin, an antistatic component comprising chitin, and said whole processed apple extract comprising a natural apple fiber component.